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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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RE/MAX International, Inc.
v.
REteam Services, L.L.C.[1]

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Opposition No. 91119995
to application Serial No. 75785419

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John R. Posthumus of Greenberg Taurig, LLP for RE/MAX International, Inc.

Daniel F. Lynch for REteam Services, L.L.C.

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Before Simms, Hanak, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

REteam Services, L.L.C. (applicant) applied to register the mark RETEAM.COM and design as shown below for services

[1] Applicant's president, Ms. Lynch, testified (Disc. dep., p. 21) that REteam Services LLC is no longer in existence. Applicant is now apparently called My REteam Services, Inc. (p. 22). USPTO records do not reflect that any paper to this effect has been filed. We note that Ms. Lynch's position with applicant is not clear. In her discovery deposition (p. 13) she identified her position as "President, I believe." In her testimonial deposition (p. 4), she identified herself as "Founder, vice president, chief cook and bottle washer."

ultimately identified as "real estate brokerage and leasing" in International Class 36."[2]

RE/MAX International, Inc. (opposer) has opposed registration on the ground that applicant's mark, when used on or in connection with the identified services, so resembles opposer's previously used and registered marks RE/MAX set out below with various services as to be likely to cause confusion or mistake or deception.

1. RE/MAX (typed) for "rendering technical aid and assistance to others in the establishment and operation of a real estate brokerage agency" in International Class 35 and "real estate brokerage services" in International Class 36.[3]
2. RE/MAX (typed) for "insurance brokerage services" in International Class 36.[4]
3. REMAX (typed) for "franchise services, namely, offering technical assistance in the

[2] Serial No. 75785419, filed September 22, 1999, is based on an allegation of a bona fide intention to use the mark in commerce.
[3] Registration No. 1,139,014, issued August 26, 1980, renewed.

establishment and/or operation of real estate brokerage firms" in International Class 35.[5]

4. REMAX (typed) for "real estate brokerage services" in International Class 36.[6]

5. RE/MAX (typed) for "providing a website on global computer networks featuring information in the field of real estate" in International Class 36.[7]

Applicant has denied the salient allegations of the notice of opposition. Opposer also argues that some of its franchisees use the term "team" along with opposer's registered marks REMAX and RE/MAX.

The Record

The record consists of the file of the involved application; the trial testimony deposition, with accompanying exhibits, of Daryl Jesperson, president of opposer; the trial testimony deposition of Mary H. Lynch, vice president of applicant;[8] the discovery deposition of Mary H. Lynch, with exhibits; and opposer's notices of

[4] Registration No. 1,339,510, issued June 4, 1985. Affidavits under Sections 8 and 15 accepted or acknowledged.
[5] Registration No. 2,054,698, issued April 22, 1997. Affidavits under Sections 8 and 15 accepted or acknowledged
[6] Registration No. 2,106,387, issued October 21, 1997. Affidavits under Sections 8 and 15, accepted or acknowledged
[7] Registration No. 2,403,626 issued November 14, 2000.
[8] Opposer moved for leave to file the testimonial deposition of Mary Lynch. At oral hearing, applicant did not object to the late submission of this deposition, and we will consider it to be of record.

reliance submitting answers to interrogatories and status and title copies of registrations.[9]

Both parties have filed briefs, and an oral hearing was held on September 11, 2003.

Priority

Priority is not an issue here to the extent that opposer relies on its ownership of five registrations for RE/MAX and REMAX marks. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).[10] Regarding opposer's franchisees who use the term "team" with opposer's RE/MAX marks, opposer alleges that "common law trademark rights have also been established in the term RE/MAX TEAM for use in connection with real estate brokerage related services." Opposer's Brief at 7. Applicant does not dispute opposer's statement of facts but this statement of fact does not demonstrate when the use of these "team" marks began. In his testimony, opposer's witness simply identified an exhibit with approximately 60 United States

[9] We have not considered applicant's list of third-party registrations set out in its brief without providing copies of the registrations prepared by the Office, or opposer's citation to a nonprecedential Board decision. TBMP §§ 101.03 and 704.03(b)(1)(B).

[10] Opposer introduced one of these registrations (No. 2,403,626), during the testimony of its witness that was not originally pled as a basis of its oppositions. Applicant has not objected to the introduction of this registration and it "does not dispute Opposer's STATEMENT OF THE FACTS." Brief at 4. Similarly, the issue of common law rights was not pleaded, but it was tried. Therefore, we deem the pleadings to be amended to conform to the evidence. Fed. R. Civ. P. 15(b).

RE/MAX offices[11] that included the term "team" in the office name such as RE/MAX DREAM TEAM in Big Rapids, Michigan and RE/MAX CENTER TEAM in Mansfield, Connecticut. The witness then agreed that it was his understanding that as of February 20, 2002, these offices were "presently doing business under these names." Jesperson dep. at 25.

We have two problems with opposer's allegations of common law rights. The underlying application is an intent-to-use applicant. Such as application has a constructive use date as of its filing date. Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991) ("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights").[12] The witness did not testify when any independently owned office began using these common law marks. While the witness identified an exhibit, the exhibit itself contains columns labeled "Start Date," "Open Date," and "Renew Date." It is not clear if the dates refer to the date of the franchise or the date the franchise chose a

[11] The remaining offices were identified as being located outside the United States.

[12] Opposer acknowledges that applicant may have asserted that it actually used its mark as of an earlier date (June 21, 1999).

specific name under which to operate. The evidence that these franchises were operating under the identified names prior to applicant's priority date is inconclusive. Several of these offices' "Start Date" was subsequent to applicant's priority date and others contain the number "2000" that suggests that these names may not have been in use as long as the franchise. Furthermore, while opposer's witness testified generally about how its owner/brokers would typically use the names of their businesses, he did not testify regarding any specific franchisee's use of the RE/MAX mark with the word "team."

Second, while there is no dispute that opposer is the owner of the RE/MAX marks, it is not clear what rights opposer has in the other terms it permits franchisees to use with its mark. The franchise agreement makes it clear that the local operator is "the owner of the Office pursuant to a franchise agreement." Jesperson Ex. 2, p. 8. For example in Jesperson Exhibit 4, opposer details the proper use of its mark with the "self-standing local name" of an office. The hypothetical example given is "RE/MAX Premier, Inc." Opposer does not appear to have rights in "Premier, Inc." and similarly opposer has not alleged that it licensed the term "team" to anyone.

Opposer's Br. at 8 n.4. The difference is not significant and applicant has not established this earlier date.

We cannot find that opposer has established by a preponderance of evidence that opposer was using the RE/MAX mark with the word "team" prior to applicant's constructive use date. Hydro-Dynamics Inc. v. George Putnam & Company Inc., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). Therefore, we conclude that opposer has not shown that it has priority regarding this common law mark.

Background

On September 22, 1999, applicant sought to register the mark "RE**team.**com" and design for "real estate brokerage and leasing."

After the application was published on August 17, 2000, opposer filed a notice of opposition.

Opposer has been using the RE/MAX trademark since 1973, which is long prior to any actual or constructive use claimed by applicant.

Applicant admits that the RE/MAX mark "is the best known in the industry" and "Applicant does not dispute that RE/MAX is a famous mark." Applicant's Br. at 13.

Likelihood of Confusion

We now address the question of whether there is a likelihood of confusion. In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

Two important factors in any likelihood of confusion analysis are the similarity of the marks and the similarity of the goods and services. We start by comparing the services of opposer and applicant. Applicant's services are identified as real estate brokerage and leasing. Opposer's registrations include "real estate brokerage services" (Nos. 2,106,387 and 1,139,014). Therefore, these services are legally identical. We note that when "marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Applicant argues that its services are directed to brokers and its literature indicates that its services are indeed marketed to real estate brokers. Lynch discovery dep. Ex. 8. However, regardless of applicant's actual methods of use and trade channels, we must consider the services as they are identified in the identification of services in the application and registrations. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ

76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). Because the services both include real estate brokerage services and there are no restrictions in the identification of services, we must assume that the services travel in "the normal and usual channels of trade and methods of distribution." CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). See also Kangol Ltd. v. KangaRoos U.S.A. 974 F.2d 161, 23 USPQ2d 1945 1946 (Fed. Cir. 1992).

> While applicant attempts to differentiate the products based on applicant's selling its products only through mail orders while opposer's sales of its goods are through ordinary retail channels of distribution, in the absence of a restriction in applicant's identification of goods and in the identification of goods in opposer's registrations, the respective goods must be presumed to travel in all channels of trade suitable for goods of that type. Accordingly, in the present case, the goods of applicant and of opposer are presumed to be sold through the same channels of distribution to the same customers and since the goods are, at least in part, virtually identical, the only issue is whether the use of the respective marks on or in connection with these goods would be likely to cause confusion for purposes of Section 2(d) of Trademark Act.

Chesebrough-Pond's Inc. v. Soulful Days, Inc., 228 USPQ 954, 956 (TTAB 1985) (citation omitted). See also In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). Therefore, we cannot find that the

services are limited to real estate professionals but we must assume that prospective purchasers include ordinary consumers seeking to sell or purchase real estate.

The next important factor in a likelihood of confusion analysis is the similarity or dissimilarity of the marks. When we compare the marks, we must compare them in their entireties rather than the individual features of the marks. In re Shell Oil, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Here, opposer's registered marks are for the terms RE/MAX or REMAX in typed form. Applicant's mark is for the term RE**team.**com and the design of "three stick figures (men) climbing up a hill. Embraced arms make the outline of a house."

Opposer's marks do not include a design. Indeed, the only feature that the marks have in common is the letters "RE." We take judicial notice of the fact that "RE" is an abbreviation for "real estate."[13] This not a case in which a party uses a series of generic or highly descriptive terms

[13] *Webster's II, New Riverside University Dictionary* (1984), p. 1351. See also *Random House Dictionary of the English Language (Unabridged)* (2d ed. 1987), p. 1605. University of Notre Dame du

to create a situation where the marks get progressively similar. See In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)

> To illustrate, assume the following pairs of hypothetical marks for identical financial services: ACCOUNT and EXCHANGE; CASH ACCOUNT and CASH EXCHANGE or MANAGEMENT ACCOUNT and MANAGEMENT EXCHANGE; CASH MANAGEMENT ACCOUNT and CASH MANAGEMENT EXCHANGE; and, finally, CASH MANAGEMENT ACCOUNT BANK and CASH MANAGEMENT EXCHANGE BANK. That these pairs are of progressively greater similarity is readily apparent, with the result that likelihood of confusion of the public becomes a closer question at each step of the progression, until it becomes virtually undeniable even though only a "generic" word, "BANK," has been added to the final stage.

Rather, the marks in this case get progressively different with opposer's addition of the term MAX and applicant's addition of the terms "team" in bold and ".com" and a distinctive design. Therefore, we conclude that the marks are not dominated by the letters "RE" even though applicant argues that both applicant and opposer use the letters "RE" to signify that the parties are "connected with real estate sales and brokerage." Applicant's Br. at 13. Indeed, because applicant has set out the word "team" in bold it appears to be the word that would attract consumer's attention. See Lynch dep. at 36 ("But it's 'team,' actually, that's in red. So 'team' is, I hope, what your average [R]ealtor comes away with").

Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Thus, there are significant differences in the pronunciation and appearance of the marks. The marks' meanings would also not be similar. If the term REMAX or RE/MAX is considered to have a meaning, it seems to suggest real estate services to the max or maximum. While applicant's mark would mean real estate team. Their overall connotation would not be similar other than the fact that they both refer to real estate, which is not surprising since they both involve real estate services.

Another important factor we discuss is the fame of opposer's marks. Applicant has conceded that the mark RE/MAX is famous and the best known mark in the industry. Opposer has also submitted evidence of significant advertising expenses, volume of sales, and number of franchises. The Federal Circuit "has acknowledged that fame of the prior mark, another du Pont factor, 'plays a dominant role in cases featuring a famous or strong mark.'" Century 21, 23 USPQ2d at 1701, quoting, Kenner Parker Toys v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). "Famous marks thus enjoy a wide latitude of legal protection." Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (FIDO LAY for edible dog treats confusingly similar to FRITO-LAY snack foods). While there is evidence of a large volume of sales and advertising for the mark REMAX, the record is silent

regarding whether the letters RE alone are associated with opposer. We emphasize that there is absolutely no other similarity between applicant's mark and opposer's registered marks beyond the letters RE. Inasmuch as the letters RE are not without meaning in the real estate field and there is no evidence of fame of that part of its mark apart from the mark as a whole, we find that the marks are not similar.

We next address the question of actual confusion. Opposer points to the testimony from applicant's witness that she was once asked if she was affiliated with RE/MAX. Opposer's Br. at 15; Lynch deposition at 15. We do not find this to be strong evidence of actual confusion. Indeed, the fact that the affiliation was raised seems to indicate that the person asking the question did not think that the company was related. Electronic Water Conditioners, Inc. v. Turbomag Corporation, 221 USPQ 162, 164 (TTAB 1984) ("That questions have been raised as to the relationship between firms is not evidence of actual confusion of their trademarks"). While we give the testimony some weight, it does not provide significant evidence that these different marks are similar.

Also, opposer argues that applicant's intent in adopting its mark supports a finding that confusion is likely. However, "an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark.

That is all that the record shows here." Sweats Fashions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). The record in this case does not establish any basis for inferring bad intent other than applicant's admitted knowledge of opposer's RE/MAX mark. Furthermore, "where there is no likelihood of confusion, the motive of the later applicant in adopting its mark cannot affect its right to registration." Electronic Water Conditioners, 221 USPQ at 165.

One last point that we address is opposer's argument that "the trade dress used in connection with Applicant's RETEAM.COM as Applicant actually uses such mark is confusingly similar to the trade dress used in connection with Opposer's RE/MAX trademark." Opposer's Br. at 16. However, while both applicant and opposer use the colors red and blue, the resulting trade dress is not very similar. Applicant uses color to emphasize the "team" portion of its mark as its drawing indicates. Lynch Ex. 10. Opposer's trade dress does not use color in this manner. The overall result is more harmonious while applicant's trade dress stands out. While "trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression"[14] in this case the trade

[14] Specialty Brands, Inc. v. Coffee Bean Distributors, 748 F.2d 669, 223 USPQ 1281, 1294 (CCPA 1984).

dress does not reinforce the minimal similarities between the marks.

When we view the marks in this proceeding under the appropriate factors, we are persuaded by the fact that the marks have little in common but the letters RE. Their overall commercial impression is not similar and therefore, we are left with only one conclusion, that the marks as used in connection with the services, are not confusingly similar. Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ 1142, 1143-44 (Fed. Cir. 1991) (FROOTEE ICE and elephant design is so different from FROOT LOOPS that even if goods were closely related and opposer's mark were famous there was no likelihood of confusion).

Decision: The opposition is dismissed.